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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,416	11/15/2001	Steven A. Morse	80121-06507	3087
758	7590	01/31/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,416

Applicant(s)

MORSE ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13, 15 and 29-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 13, 15 and 29-36 is/are allowed.
- 6) ☒ Claim(s) 37-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Nov. 23, 2005 has been entered.

Claims 45-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 45, line 9, "disabling" is indefinite since it is unclear what is disabled.

Claims 37-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,331,975) in view of Bonutti (5,197,971). Bonutti (5,331,975), in figures 3 and 21, discloses elongated cannula 38, endoscope 40 and endoscopic instrument (the retractor 272 shown in figure 21 including a bladder comprising a partial ring which is an alternative embodiment to the bladder 46 shown in figure 3). Bonutti (5,331,975) fails to disclose the endoscopic instrument 272 as being supported for translation to a retracted position wherein the partial ring resides about a distal end of the endoscope.

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However, it is clear that the bladder 272, when deflated, is inserted into the proximal (physician) end of the cannula prior to its insertion into the body and when so inserted, would be in a retracted position wherein the partial ring resides about a distal end of the endoscope 40. In any event, Bonutti (5,197,971) teaches that a similar bladder 362 is disposed within retractor 350 during its insertion in the body (col. 13, lines 54-57) which has the apparent advantage of protecting the bladder from any abrasion from the tissue as it is so inserted. It would have been obvious to retract the Bonutti (5,331,975) endoscopic instrument 272 into the cannula 38 during its insertion into the body so that it too would have this advantage. As to claims 39 and 47, partial ring 272 of Bonutti (5,331,975) is a tissue dissector as indicated in col. 3, lines 21-30 and col. 7, lines 8-21 and 38-41. As to claims 43 and 50, Bonutti (5,331,975) fails to disclose a fluid seal. However, it is old and well known in this art to provide fluid seals between the inner surface of a cannula and instruments or scopes inserted therein in order to obtain the advantage of preventing blood and gases from escaping from the patient. It would have been obvious to provide such a seal in the Bonutti (5,331,975) cannula so that it too would have this advantage. The above well known in the art statement is taken to be admitted prior

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art because applicant failed to traverse the examiner's assertions (M.P.E.P. 2144.03). As to claims 44 and 51, endoscope 40 is recessed within the distal end of the cannula during insertion of the endoscope into the cannula.

Claims 12, 13, 15 and 29-36 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
1/20/06



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731